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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,873	03/22/2001	Steven G. Roskowski	18602-05889	5394

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EXAMINER

PEYTON, TAMMARA R

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,873

Applicant(s)

ROSKOWSKI ET AL.

Examiner

Tammara R Peyton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Reissue

Claims 1-30 are rejected as being based upon a defective reissue 09/815/873 under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) does include not adequately identify at least one error as per CFR 1,175. Stating that one filed a broadening reissue to "remove limitations", without identifying the specific feature is not adequate. Furthermore, an exact copying of the new claim does not meet the requirement. To merely reproduce the claims with brackets and underlining and state that such will identify the error is not sufficient. See MPEP 1414.

There was no offer to surrender the patent. The original patent, or an affidavit or declaration as to the loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Recapture/Broadening

1. Claims 23-30 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue that was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

a. In the reissue application, new claims 23, 26, and 28 now presents the same language as claims 1, 4, 8, and 14, except that it does not contain: (A) "always utilizing the first clock without synchronization to another clock".

Claims 23, 26, and 28 are broader in that it eliminates (A). This provides a broadening aspect to the reissue claim to exclude the (A) limitation that was clearly argued in Amendment C, (paper number 7, page number 8, filed

02/22/94), of the original application to overcome the rejection based on the Wolf reference (US Patent 4,525,849). Thus, the omission of (A) in reissue claims 23, 26, and 28 constitutes recapture are thereby rejected, because reissue claims 23, 26, and 28 are broader in a manner directly pertinent to the subject matter that applicant surrendered during the prosecution.

b. In the reissue application, new claims 23, 26, and 28 now presents the same language as claims 1, 4, 8, and 14, except that it does not contain: (B) "the timing of said first clock being independent of the timing of said second clock".

Claims 23, 26, and 28 are broader in that it eliminates (B). This provides a broadening aspect to the reissue claim to exclude the (B) limitation that was clearly argued in Amendment D, (paper number 13, page numbers 6-8, filed 12/22/95), of the original application to overcome the rejection based on the Bentey et al. reference (US Patent 4,860,193) and Carmon et al. (US Patent 5,291,468). Thus, the omission of (2) in reissue claims 23, 26, and 28 constitutes recapture are thereby rejected, because reissue claims 23, 26, and 28 are broader in a manner directly pertinent to the subject matter that applicant surrendered during the prosecution.

c. In reissue application, new claims 23, 26, and 28 now presents the same language in claim 1, except that it does not contain the limitation: (C) "means for switching the second clock to terminal used by the first clock; said means for switching

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the second clock to the terminals used by the first clock includes a multiplexer". Claims 23, 26, and 28 are broader in that it eliminates (C). This provides a broadening aspect to the reissue claim to exclude the (C) limitation that was clearly argued in Interview Summary, paper number 18 and added to claim 1 in Examiner's Amendment F, (paper number 19, paper number 3, filed 12/10/96), of the original application to overcome the rejection based on the Ambrosius, III et al. reference (US Patent 4,527,233). Thus, the omission of (C) in reissue claims 23, 26, and 28 constitutes recapture are thereby rejected, because reissue claims 23, 26, and 28 are broader in a manner directly pertinent to the subject matter that applicant surrendered during the prosecution.

2. The following claims have broadening issues, but the broadening is not related to the prior art, therefore it does not constitute improper broadening/recapture.

a. In reissue application, new claims 23, 26, and 28 now presents the same language in claim 1, except that it does not contain the limitation: (D) "without need for storage by the second component". This provides a broadening aspect to the reissue claim that was never argued in the original application to overcome the rejection based on the references Wolf, Bentey et al., Carmon et al., and Mortensen et al. (US Patent 4,542,457). Thus, omission of (D) is not related to subject matter surrendered in the original application. See *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295, (Fed. Cir. 1984)

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b. In reissue application, new claims 23, 26, and 28 now presents the same language in claims 1, 4, 8, and 14, except it now contains the narrowing limitation: (E) "a multiplexer having inputs coupled to the first clock signal and the second clock signal, and an output coupled to the buffer.." This provides a narrowing aspect to the reissue claim that was never argued in the original application to overcome the rejection based on the references Wolf, Bentey et al., Carmon et al., Mortensen et al., and Ambrosius, III et al. Thus, omission of (E) is not related to subject matter surrendered in the original application. See *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295, (Fed. Cir. 1984)

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

a. Throughout claim 1 it recites the limitations "transfer information" [col. 7, line 63, and col. 8, lines 2 and 8], "transfer other data" [col. 8, line 4], and "transfer data" [col. 8, line 22]. There is insufficient antecedent basis for ~~this~~ ^{these} limitations.

in the claim. Examiner is unsure what "data" is being "transferred". Please clarify.

- b. Claim 1 recites the limitation "said buffer", [col. 8, line 22]. There is insufficient antecedent basis for this limitation in the claim.
- c. Claim 2 recites the limitation "the storage", [col. 8, line 25]. There is insufficient antecedent basis for this limitation in the claim.
- d. Claim 2 recites the limitation "the buffer", [col. 8, line 29]. There is insufficient antecedent basis for this limitation in the claim.
- e. Claim 3 recites the limitation "the buffer", [col. 8, line 34]. There is insufficient antecedent basis for this limitation in the claim.
- f. Claim 4 recites the limitation "address components", [col. 8, lines 57-58]. There is insufficient antecedent basis for this limitation in the claim.
- g. Claim 4 recites the limitation "the means for storage", [col. 8, line 42]. There is insufficient antecedent basis for this limitation in the claim.
- h. Claim 4 recites the limitation "a first component", "a second component", [col. 8, line 60]. Examiner is unsure how these components relate to the components defined earlier in the claim. There is insufficient antecedent basis for this limitation in the claim.
- i. Claim 4 recites the limitation "a second clock signal from said second clock", [col. 8, line 62]. Examiner is unsure how the "second clock signal from said second clock" relates to the "any clock signal" defined earlier in the claim,

because there was no first clock signal ever defined. There is insufficient antecedent basis for this limitation in the claim.

- j. Claim 4 recites the limitation "said buffer", [col. 8, lines 62-63]. There is insufficient antecedent basis for this limitation in the claim.
- k. Claim 4 recites the limitation "transfer data", [col. 8, line 63]. There is insufficient antecedent basis for this limitation in the claim.
- l. Claims 5 recites the limitations "another of the components", [col. 8, line 65] and "the other of the components", [col. 8, lines 66-67]. Claim 6 recites the limitation "the components", [col. 9, line 5]. Claim 7 recites the limitation "each of the components", [col. 9, lines 8-9]. Examiner is unsure which components the claims are referring to. For example, are the claims referring to "any component" or the "destination component" defined in claim 4. There is insufficient antecedent basis for this limitation in the claim.
- m. Claim 5 recites the limitation "the means for storing", [col. 8, line 66]. There is insufficient antecedent basis for this limitation in the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703)

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306-5508. The examiner can normally be reached between 8:00 - 4:30 from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.

Faxes for Official/formal communications intended for entry should be sent to:

(703) 746-7238, After Final (703)746-7239

or, for informal or draft communications, to:

(703) 746-7240 (please label "PROPOSED" or "DRAFT").


Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive, Arlington, VA, ^{Fourth}~~Sixth~~ Floor

(Receptionist).

Tammara Peyton

May 14, 2002


JEFFREY GAFFIN
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